

### **REMARKS/ARGUMENTS**

This Amendment is being filed in response to the first Official Action on a Request for Continued Examination. The Official Action initially rejects method Claims 58-79 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Applicants respectfully disagree, but nonetheless have amended independent Claim 58 to further clarify that the recipient includes a processor and a memory storing executable instructions that in response to execution by the processor cause the recipient to at least perform the determining an upload schedule. Applicants therefore respectfully submit that independent Claim 58, and by dependency Claims 59-79, satisfy the machine-or-transformation test enumerated by the Federal Circuit in *In re Bilski*. Applicants therefore respectfully submit that the rejection of Claims 58-79 as being directed to non-statutory subject matter is overcome.

Initially, Applicants appreciate the Examiner taking the time to speak with Applicants' undersigned attorney regarding clarification of the treatment of various ones of the claims in the Official Action. The following is Applicants understanding of the treatment of the claims; however, Applicants respectfully request that the Examiner confirm the same.

In addition to the foregoing § 101 rejection, the Official Action rejects Claims 23, 34, 35, 45, 51, 52, 58, 69, 70, 80, 91, 92, 102, 113 and 114 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0142780 to Airy et al. The Official Action rejects Claims 24, 29, 30, 48, 64, 65, 86, 87, 103, 108 and 109 under 35 U.S.C. § 103(a) as being unpatentable over Airy, in view of U.S. Patent Application Publication No. 2002/0194205 to Brown et al.; rejects Claims 25-28, 46, 47, 60-63, 82-85 and 104-107 as being unpatentable over Airy, in view of U.S. Patent No. 7,257,386 to McDonnell et al.; rejects Claims 33, 37-42, 50, 53-57, 68, 72-77, 90, 94-99, 112 and 116-121 as being unpatentable over Airy, in view of U.S. Patent Application Publication No. 2003/0120802 to Kohno; rejects Claims 32, 49, 67, 89 and 111 as being unpatentable over Airy, in view of U.S. Patent Application Publication No. 2004/0198426 to Squibbs et al.; rejects Claims 36, 71, 93 and 115 as being unpatentable over Airy, in view of PCT Patent Application Publication No. WO 2003/026216 to Kobayashi; rejects Claims 31, 66, 88 and 110 as being unpatentable over Airy in view of Brown, and further in view of Kohno; and rejects Claims 43, 44, 78, 79, 100, 101, 122 and 123 as being

unpatentable over Airy in view of Kohno, and further in view of U.S. Patent Application Publication No. 2003/0084128 to Anderson.

As explained below, however, Applicants respectfully submit that the claimed invention is patentably distinct from Airy, Brown, McDonnell, Kohno, Squibbs, Kobayashi and Anderson, taken individually or in any proper combination. Nonetheless, Applicants have amended various ones of the claims to further clarify the claimed invention. In view of the amendments to the claims and the remarks presented herein, Applicants request reconsideration and allowance of all of the pending claims of the present application.

**A. Claim Construction and Prima Facie Anticipation/Obviousness**

Applicants note that the Patent Office has the initial burden of proof in establishing *prima facie* anticipation or obviousness of a claimed invention under 35 U.S.C. § 102 or § 103. *In re Warner*, 379 F.3d 1011, 1016 (CCPA 1967). To make a fair review of the merits of a *prima facie* case of anticipation or obviousness, “[t]he Examiner must make specific findings as to claim construction.” *Ex parte* Beery, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte* Blankenstein et al., Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07. And as has been held by the Court of Appeals for the Federal Circuit, “[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference.” *Lindemann Maschinenfabrik v. American Hoist and Derrick Company*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added); and *see Waldermar Link v. Osteonics Corp.*, 32 F.3d 556, 559 (Fed. Cir. 1994) (explaining that, during prosecution, “the patent Examiner acts as a fact-finder”).

In the present Official Action, the Office has failed to provide Applicants with a sufficient claim construction or interpretation of the cited references so as to enable the Applicants to make a fair review of the merits of the case of anticipation or obviousness proffered by the Examiner, or to effectively reply. Other than quoting or paraphrasing

Applicants' claim language with annotated citations to figures, or column and line numbers of the cited references, the Examiner provides no finding or other explanation regarding Applicants' claims, the cited references, or the application of the cited references to Applicants' claims.

In the present Official Action, the Examiner states that "it is clear to one of ordinary skill in the art at the time of the invention was made that the paragraphs the examiner has cited is sufficient on the basis alone to be able to understand how the cited matter reads on applicants claim." Official Action of May 12, 2009, p. 18. However, the Board of Patent Appeals has found that the mere citing of passages of the prior art is insufficient to meet the Examiner's "initial burden of pointing out where the applied prior art teaches or suggests Appellant's invention." *Ex parte* Beery, Appeal No. 2008-0543, page 5. As stated by the Board in *Ex parte* Beery, "The difficulty we have with the Examiner's position is its failure to specifically point out where in the cited passages there is found a teaching of each of the disputed claim limitations." *Id.*

Applicants therefore respectfully or again respectfully submit that the Examiner has failed to establish *prima facie* anticipation or obviousness of the claimed invention. Should the Examiner continue to reject the claims as being unpatentable over the same or any other ground, Applicants respectfully request that the Examiner submit on the record specific findings as to the construction being applied to the claims, an explanation of the references being cited against the claims, and how those references disclose recited features of the claims.

***B. Claims 23, 34, 35, 45, 51, 52, 58, 69, 70, 80, 91, 92, 102, 113 and 114 are Patentable***

The Official Action rejects Claims 23, 34, 35, 45, 51, 52, 58, 69, 70, 80, 91, 92, 102, 113 and 114 as being anticipated by Airy. According to one aspect of the claimed invention, as reflected by independent Claim 23, an apparatus is provided that includes a processor and a memory storing executable instructions that in response to execution by the processor cause the apparatus to at least perform a number of functions. As recited, the functions include providing for sending an upload request to a recipient, where the upload request comprising a request to

upload content from the apparatus to the recipient; providing for receiving, from the recipient in response to the upload request, an upload schedule relating to at least one of the time or manner of uploading the content; and uploading the content to the recipient in accordance with the upload schedule.

In contrast to independent Claim 23, Airy does not teach or suggest providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule. Airy does disclose a schedule or map that divides time and frequency for a time and frequency division multiplexing scheme (TDM-FDM combination) in which subscriber stations wirelessly communicate with a base transceiver station. A schedule of time and frequency slots in a division multiplexing scheme, however, is not commensurate with an upload schedule, nor is wireless transmission between a subscriber station and base transceiver station commensurate with uploading content.

Applicants acknowledge that during prosecution, pending claims must be given their broadest reasonable interpretation. Applicants submit, however, that the broadest reasonable interpretation must be consistent with the specification. MPEP § 2111. And as explained in the MPEP, “[c]laim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art.” MPEP § 2111.01 (II.), *citing Sundance Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003). Consistent with the specification and its ordinary and customary meaning, “upload” may be interpreted as a transfer from a local apparatus to another, remote apparatus for storage in memory of the other apparatus. *See* Merriam-Webster Online, Definition of “Upload” (visited Jun. 29, 2009) <<http://www.merriam-webster.com/dictionary/upload>> (defining “upload” as “to transfer (as data or files) from a computer to the memory of another device (as a larger or remote computer)”; and IEEE, IEEE 100: AUTHORITATIVE DICTIONARY OF IEEE STANDARDS TERMS (7th ed.) 1240 (defining “upload” as “[t]o transfer some collection of data from the memory of a small computer to the memory of a relatively larger computer”).

Applicants therefore respectfully submit that independent Claim 23, and by dependency Claims 24-44, is patentably distinct from Airy. Applicants also respectfully submit that independent Claims 45, 58, 80 and 102, recite subject matter similar to that of independent Claim

23, including the aforementioned upload schedule and uploading content in accordance with an upload schedule. As such, Applicants respectfully submit that independent Claims 45, 58, 80 and 102, and by dependency Claims 46-57, 60-79, 82-101 and 103-123, are also patentably distinct from Airy, for at least the reasons given above with respect to independent Claim 23.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 23, 34, 35, 45, 51, 52, 58, 69, 70, 80, 91, 92, 102, 113 and 114 as being anticipated by Airy is overcome.

***C. Claims 24, 29, 30, 48, 64, 65, 86, 87, 103, 108 and 109 are Patentable***

The Official Action rejects Claims 24, 29, 30, 48, 64, 65, 86, 87, 103, 108 and 109 as being unpatentable over Airy, in view of Brown. As explained above, independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy. Applicants respectfully submit that Brown does not cure the deficiencies of Airy. That is, even considering Brown, neither Airy nor Brown, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy and Brown, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 24, 29, 30, 48, 64, 65, 86, 87, 103, 108 and 109 as being unpatentable over Airy, in view of Brown is overcome.

***D. Claims 25-28, 46, 47, 60-63, 82-85 and 104-107 are Patentable***

The Official Action rejects Claims 25-28, 46, 47, 60-63, 82-85 and 104-107 as being unpatentable over Airy, in view of McDonnell. As explained above, independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy. Applicants respectfully submit that McDonnell does not cure the

deficiencies of Airy. That is, even considering McDonnell, neither Airy nor McDonnell, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy and McDonnell, taken individually or in any proper combination.

In addition to the foregoing, Applicants respectfully submit that Claims 25-28, 46, 47, 60-63, 82-85 and 104-107 recite features further patentably distinct from Airy and McDonnell, taken individually or in any proper combination. As recited by these claims in various manners, the upload schedule includes instruction(s) dependent upon the state of the recipient, sender and/or network(s) over which the content is uploaded. Information reflecting the current state of recipient, sender and/or network(s) is received before uploading the content, with uploading the content being based on the respective instruction(s) and information.

The Official Action concedes that Airy does not teach or suggest providing for receiving state information regarding the recipient, sender and/or network(s), or uploading content based upon the state information. The Official Action alleges that McDonnell discloses these features, and that it would have been obvious to one skilled in the art to modify Airy per McDonnell to teach the claimed invention. Applicants respectfully disagree, and submit that even if one could argue (albeit incorrectly) that McDonnell discloses uploading content based upon state information regarding the recipient, sender and/or network(s), there is no apparent reason to modify Airy per McDonnell to teach or suggest any of Claims 25-28, 46, 47, 60-63, 82-85 and 104-107.

Again, Airy discloses a schedule or map that divides time and frequency for a time and frequency division multiplexing scheme (TDM-FDM combination) in which subscriber stations wirelessly communicate with a base transceiver station. McDonnell, on the other hand, discloses a data transfer scheme whereby data may be selectively transferred across a lower-bandwidth network (e.g., PLMN) or a higher-bandwidth network. One may therefore argue an apparent reason to combine Airy and McDonnell whereby Airy's TDM-FDM combination – and hence its

schedule – are implemented for communication across the lower-bandwidth network or higher-bandwidth network. Even in such an instance, however, the combination still does not include an upload schedule with instruction(s) dependent upon the state of the recipient, sender and/or network(s).

For at least the foregoing reasons, Applicants submit that the rejection of Claims 25-28, 46, 47, 60-63, 82-85 and 104-107 as being unpatentable over Airy, in view of McDonnell is overcome.

***E. Claims 33, 37-42, 50, 53-57, 68, 72-77, 90, 94-99, 112 and 116-121 are Patentable***

The Official Action rejects Claims 33, 37-42, 50, 53-57, 68, 72-77, 90, 94-99, 112 and 116-121 as being unpatentable over Airy, in view of Kohno. As explained above, independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy. Applicants respectfully submit that Kohno does not cure the deficiencies of Airy. That is, even considering Kohno, neither Airy nor Kohno, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy and Kohno, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 33, 37-42, 50, 53-57, 68, 72-77, 90, 94-99, 112 and 116-121 as being unpatentable over Airy, in view of Kohno is overcome.

***F. Claims 32, 49, 67, 89 and 111 are Patentable***

The Official Action rejects Claims 32, 49, 67, 89 and 111 as being unpatentable over Airy, in view of Squibbs. As explained above, independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from

Airy. Applicants respectfully submit that Squibbs does not cure the deficiencies of Airy. That is, even considering Squibbs, neither Airy nor Squibbs, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy and Squibbs, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 32, 49, 67, 89 and 111 as being unpatentable over Airy, in view of Squibbs is overcome.

***G. Claims 36, 71, 93 and 115 are Patentable***

The Official Action rejects Claims 36, 71, 93 and 115 as being unpatentable over Airy, in view of Kobayashi. As explained above, independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy. Applicants respectfully submit that Kobayashi does not cure the deficiencies of Airy. That is, even considering Kobayashi, neither Airy nor Kobayashi, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy and Kobayashi, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 36, 71, 93 and 115 as being unpatentable over Airy, in view of Kobayashi is overcome.

***H. Claims 31, 66, 88 and 110 are Patentable***

The Official Action rejects Claims 31, 66, 88 and 110 as being unpatentable over Airy, in view of Brown, and further in view of Kohno. As explained above, independent Claims 23, 45,



58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy. Applicants respectfully submit that neither Brown nor Kohno cures the deficiencies of Airy. That is, even considering Brown and Kohno, none of Airy, Brown or Kohno, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy, Brown and Kohno, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 31, 66, 88 and 110 as being unpatentable over Airy, in view of Brown, and further in view of Kohno is overcome.

***I. Claims 43, 44, 78, 79, 100, 101, 122 and 123 are Patentable***

The Official Action rejects Claims 43, 44, 78, 79, 100, 101, 122 and 123 as being unpatentable over Airy, in view of Kohno, and further in view of Anderson. As explained above, independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy. Applicants respectfully submit that neither Kohno nor Anderson cures the deficiencies of Airy. That is, even considering Kohno and Anderson, none of Airy, Kohno or Anderson, taken individually or in any proper combination, teaches or suggests the aforementioned providing for receiving an upload schedule from a recipient, and uploading content to the recipient in accordance with the upload schedule, as per independent Claims 23, 45, 58, 80 and 102. Applicants therefore respectfully submit that independent Claims 23, 45, 58, 80 and 102, and by dependency Claims 24-44, 46-57, 60-79, 82-101 and 103-123, are patentably distinct from Airy, Kohno and Anderson, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 43, 44, 78, 79, 100, 101, 122 and 123 as being unpatentable over Airy, in view of Kohno, and further in view of Anderson is overcome.

**CONCLUSION**

In view of the amendments to the claims and the remarks presented herein, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Andrew T. Spence  
Registration No. 45,699

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111  
LEGAL02/31381949v1

**ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON JULY 1, 2009.**